



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,937	10/21/2003	Sandrine Chodorowski-Kimmes	033924-003	3195

21839 7590 02/17/2006

BUCHANAN INGERSOLL PC
(INCLUDING BURNS, DOANE, SWECKER & MATHIS)
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

DODSON, SHELLEY A

ART UNIT PAPER NUMBER

1616

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/688,937	Applicant(s) CHODOROWSKI-KIMMES ET AL.	
	Examiner SHELLEY A. DODSON	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

SHELLEY A. DODSON
 PRIMARY EXAMINER

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/04 AND 8/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1.

Claims 1-36 are pending in this application filed 10/21/2003.

Applicant's claims are directed toward dibenzoylmethane sunscreen compositions photostabilized with amphiphilic block copolymers.

Claim Rejections - 35 USC § 112

2.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention. Applicant has failed to specify which average molecular weight is used to define the molecular weight as claimed by the applicant in the instant case. The average molecular weight of a polymer is determined by a weight average, a number average, a viscosity average or a Z average. The four different types of average molecular weights mentioned above vary widely in numerical values for the same polymer. To merely state the molecular weights as bare numbers without any explanation as to how they were determined or arrived at is insufficient.

3.

Claims 2 and 23 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

4.

Claims 2 and 23 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 23 are viewed as indefinite in that molecular weights which are expressed as bare numbers only is meaningless without specifying which average molecular weight is used to define the above property of the polymer, i.e. is the average molecular weight a weight average, a number average, a viscosity average or a Z average molecular weight. These are the four different types of average molecular weights with each varying widely in numerical values for the same polymer. To simply state the molecular weights as bare numbers without any explanation as to how they were determined or arrived at is viewed as indefinite.

Claim Rejections - 35 USC § 102

5.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6.

Claims 1-36 are rejected under 35 U.S.C. 102(e) as being anticipated by L'Alloret USP No. 6,994,846 B2.

L'Alloret discloses compositions for cosmetic or dermatological use containing a triblock polymer. In columns 2 through 13, L'Alloret further discloses a variety of specific diblock and triblock polymers, more specifically at least one hydrophilic and at least one hydrophobic block in the same amounts and proportions claimed by applicant in the instant case. In columns 18-20, L'Alloret further discloses that specific sunscreening agents are also present. In column 18, lines 60-64, L'Alloret specifically discloses Parsol 1789 as claimed by applicant. In column 20, lines 25-45, L'Alloret teaches coated metal oxides, more specifically, titanium oxide or zinc oxide. In column 21, L'Alloret teaches that said compositions may be in the form of gels, lotions, milks, pastes and creams. Further in column 21, lines 30-55, L'Alloret discloses that the compositions are used as hair products and make-up for the skin, scalp, hair, the

eyelashes, eyebrows, the nails or the mucous membranes. In columns 17 and 18, L'Alloret further discloses that other active agents may also be present as claimed by applicant. Although L'Alloret fails to specifically state that the copolymers are stabilizers for the sunscreens it is the Examiner's position that it is an inherent characteristic of the composition since it is the same composition claimed by applicant. Additionally, with respect to the composition, statements of intended use are of no patentable distinction when the composition is found in the prior art.

Information Disclosure Statement

7.

The information disclosure statements (IDS) submitted on 2/12/2004 and 8/17/2005 were noted and the submissions are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statements and made them of record.

Telephone Inquiries

8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley A. Dodson whose telephone number is (571) 272-0612 and fax number (571) 273-0612. The examiner can normally be reached on Monday-Thursday from 7:30 a.m. to 5:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached at (571) 272-0629.


9.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. This new location should be used in all instances when faxing any correspondence numbers to Group 1600. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

Serial No. 10/688,937
Art Unit 1616

-8-

applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Shelley A. Dodson
Primary Examiner
Art Unit 1616

February 16, 2006